REMARKS/ARGUMENTS

Status of Claims

Claims 1-56 are pending in the application.

Claims 1 and 46 are hereby amended.

Applicants hereby request further examination and reconsideration of the presently claimed application.

Allowable Subject Matter

Applicants note with appreciation the allowance of claims 6, 7, and 56 and the indication that claims 24-31, 33, 36, 39-41, and 51 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. *See* Final Office Action dated November 2, 2006.

Claim Rejections – 35 U.S.C. § 102

On February 6, 2007, a telephonic interview (the "Interview") was conducted between Applicants' representative, Rodney B. Carroll, Esq., and Patent Examiner, Matthew J. Smith. During the Interview, Mr. Carroll presented Applicants' interpretation of *Scherbatskoy* (U.S. 4,416,000) and how *Scherbatskoy* should not be deemed to affect the patentability of the instant application. Examiner Smith was cordial and receptive to Mr. Carroll's position, but clearly stated before accepting the instant application in condition for allowance that he believed it would be most prudent to discuss Mr. Carroll's position with his colleagues. On February 14, 2007, the Advisory Action was mailed detailing Examiner Smith's ultimate conclusion. Examiner Smith explained that the consensus opinion between himself, and Primary Examiners, J. Gay and K. Thompson, was that, "the byproduct of an electrically powered process is still considered anticipated by Scherbatskoy." *See* Advisory Action at 3.

Respecting the Examiner's conclusion, Applicants offer the following amendments to claims 1 and 46:

> 1. (Currently Amended) A method of preparing an energy storage device for powering a downhole tool, comprising: heating an energy storage device to an effective temperature to improve operability of the energy storage device, wherein the heat used to heat the energy storage device is a product of a non-electrically powered process ~~or a byproduct of an electrically powered process~~.

and

> 46. (Currently Amended) A system for preparing an energy storage device for powering a downhole tool, comprising: the energy storage device and a heat source for heating the energy storage device, wherein the heat used to heat the energy storage device is a product of a non-electrically powered process ~~or a byproduct of an electrically powered process~~.

Support for the claim language can be found in the specification. *See, e.g.*, Application paragraph [0020] ("[A]n embodiment is depicted in which reactants being fed to an acid fuel cell 22 are pre-heated by heat generated by the fuel cell itself."). Previously presented claims 15 and 53 also recite a "non-electrically powered" heater which is consistent with the scope of amended claims 1 and 46. Applicants have amended the instant application's claims to comply with the Examiner's interpretation and application of *Scherbatskoy* to the instant application. Accordingly, all claims rejected as anticipated by *Scherbatskoy* are now presented in condition for allowance. Specifically, claims 1-5, 8, 10, 11, 15, 17, 18, 34, 35, 37, 38, 44-47 and 52-55 are now in condition for allowance.

Claim Rejections – 35 U.S.C. § 103

The November 2, 2006 Final Office Action ("Final Office Action") rejected claims 9, 14, 16, 19, 20, 42, 43, and 48 under 35 U.S.C. § 103(a) as being unpatentable over *Scherbatskoy* in view of *Blake* (U.S. 4,314,008). The Final Office Action rejected claims 12, 49, and 50 under 35

U.S.C. § 103(a) as being unpatentable over *Scherbatskoy* in view of *Ashtiani* (U.S. 6,259,229). The Final Office Action rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Scherbatskoy* in view of *Ashtiani* (U.S. 6,259,229) and in further view of *Reiss* (U.S. 4,692,363). The Final Office Action rejected claims 21-23 and 32 under 35 U.S.C. § 103(a) as being unpatentable over *Scherbatskoy* in view of *VanBerg, Jr.* (U.S. 5,202,194). Thus, claims 9, 12, 13, 14, 16, 19-23, 32, 42, 43, 48, 49, and 50 stand or fall on the application of *Scherbatskoy* to the claims.

The requirements for establishing a *prima facie* case of obviousness are well established:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. MPEP § 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As explained in reference to the current amendments made to claims 1 and 46 to overcome *Scherbatskoy*, pursuant to the Examiner's interpretation and application of *Scherbatskoy* contained in the Advisory Action, *see* Advisory Action at 3, *Scherbatskoy* no longer can be read to teach or suggest the limitations contained in claims 1 and 46. In addition, all dependent claims incorporate the limitations of the claims they depend on. Because claims 9, 12, 13, 14, 16, 19-23, 32, 42, 43, 48, 49, and 50 depend on and; therefore, incorporate the limitations of amended claims 1 and 46, and *Scherbatskoy* cannot be read to teach the limitations of amended claims 1 and 46, *Scherbatskoy* can no longer serve as anticipatory art for claims 9, 12, 13, 14, 16, 19-23, 32, 42, 43, 48, 49, and 50. The Examiner does not cite the remaining prior art references to teach the

limitations that are absent from *Scherbatskoy*. Thus, a *prima facie* case of obviousness has not been presented as to claims 9, 12, 13, 14, 16, 19-23, 32, 42, 43, 48, 49, and 50, which are allowable over the cited prior art.

CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections are respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Advisory Action dated February 14, 2007 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,
CONLEY ROSE, P.C.

Date: 2-28-07

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